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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,569	02/20/2004	Christine Garcia	0503-1141	7546
466 7590 06/09/2008 YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314			EXAMINER SOROUSH, ALI	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 06/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/783,569

Applicant(s)

GARCIA, CHRISTINE

Examiner

ALI SOROUSH

Art Unit

1616

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-37 is/are pending in the application.
- 4a) Of the above claim(s) 14, 19 and 32-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-13, 15-18 and 20-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgement of Receipt

Applicant's response filed on 02/29/2008 in response to the Office Action mailed on 11/30/2007 is acknowledged.

Status of the Claims

Claims 1-9 are cancelled, claims 14, 19, and 32-37 are withdrawn, and claim 10 is currently amended. Therefore, claims 10-13, 15-18, and 20-31 are currently pending examination for patentability.

Rejections and/or objections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-13, 15-18, and 20-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 provides for the use of a composition as a slimming agent, but, since the claim does not set forth any steps involved in the method/process, it is unclear what

method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Response to Applicants Arguments

Applicant argues that the amendment filed with the aforementioned response overcomes the rejection on the grounds of indefiniteness. Applicant's arguments have been fully considered and found not to be persuasive.

Applicant claims a method of using a composition without setting forth any active step and further without setting forth a clear method since it seems the preamble of the claim appears to be incomplete. The amendment "adding a composition having lypolytic activity to a formulation containing a cosmetically acceptable medium" and further "that reduces triglyceride content in adipocyte cells" makes it unclear if applicant is claiming a method of formulating a composition comprising the slimming agent represented by formula I or if applicant is claiming a method of reducing triglyceride content in adipocyte cells. If it is the latter is also unclear by what means this composition would be utilized to achieve the reducing triglyceride content in adipocyte cells effect. For the foregoing reasons the rejection of claims 10-13, 15-18, and 20-31 under 35 U.S.C. 112, second paragraph, **is maintained**.

Claim Rejections - 35 USC § 101

Claims 10-13, 15-18, and 20-31 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process,

Art Unit: 1616

results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Response to Applicants Arguments

Applicant argues that the amendment filed with the aforementioned response overcomes the rejection on the grounds of indefiniteness. Applicant's arguments have been fully considered and found not to be persuasive.

Applicant claims a method of using a composition without setting forth any active step and further without setting forth a clear method since it seems the preamble of the claim appears to be incomplete. The amendment "adding a composition having lypolytic activity to a formulation containing a cosmetically acceptable medium" and further "that reduces triglyceride content in adipocyte cells" makes it unclear if applicant is claiming a method of formulating a composition comprising the slimming agent represented by formula I or if applicant is claiming a method of reducing triglyceride content in adipocyte cells. If it is the latter is also unclear by what means this composition would be utilized to achieve the reducing triglyceride content in adipocyte cells effect. For the foregoing reasons the rejection of claims 10-13, 15-18, and 20-31 under 35 U.S.C. 101 is maintained.

New Grounds of Rejection

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-13, 15-18, 20-29 and 30 rejected under 35 U.S.C. 102(b) as being anticipated by Stoltz (US Patent 6296859 B1, Published 10/02/2001).

Stoltz teaches, "Synergistic composition comprising a compound of lipoamino acid structure and a water lily extract". (See title). "One subject of the invention is a composition characterized in that it comprises as an active principle at least one compound of formula (I):" $R-CO-(NH-CH(R_1)-CO)_m-OH$ " or its topically acceptable salts, in which R represents the characterizing chain of a saturated or unsaturated, linear or branched fatty acid containing from 3 to 30 carbon atoms, R_1 represents the characterizing chain of an amino acid and m is between 1 and 5, and the constituents of at least one extract and/or of at least one tincture from plants of the Nymphaeaceae family." (See column 2, Lines 11-27). "The compound of formula (I) present in the composition which is subject of the present invention can be in free acid form or in partially or totally salified form." (See column 2, Lines 40-43). " R_1 represents in particular the characterizing chain of one of amino acids chosen from glycine, alanine, serine, aspartic acid, glutamic acid, valine, threonine, arginine, lysine, proline, leucine, phenylalanine, isoleucine, histidine, tyrosine, tryptophan, asparagine, cysteine, cystine, methionine, hydroxyproline, hydroxylysine, and ornithine." (See column 3, Lines 12-17). "One subject of the invention, is particularly, a cosmetic composition comprising, as active principle, from 0.001% to 6% by weight of at least one compound of formula(I) and from 0.0005% to 1% by weight of constituents of at least one extract (II) and /or of at least one tincture from a plant of the Nymphaeaceae family and, if desired, up to 1% of zinc gluconate." (See column 6, Lines 4-10). "Depending on the use, the composition as

described above is used at different concentrations and in formulation which is suitable for this use; such cosmetic compositions are usually in the form of aqueous solutions, dilute alcoholic solutions, or simple or multiple emulsions ..." (See column 5, Lines 32-36). In preferred example a slimming gel is formed from a combination of the lipamino acid, water lily extract, a thickner, ethanol, methanol, caffeine, extract of butchers broom, extract of ivy, a preserving agent, and water. (See column 16, example 26). For the foregoing reasons the instant method is anticipated.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Soroush whose telephone number is (571) 272-9925. The examiner can normally be reached on Monday through Thursday 8:30am to 5:00pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

Art Unit: 1616

Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ali Soroush
Patent Examiner
Art Unit: 1616

/Mina Haghighatian/
Primary Examiner
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